

DOCKET NO.

TSX-0001-CPA



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: Thomas E. SAWYER et al.

ART UNIT: 3714

SERIAL NO.: 08/918,944

EXAMINER: Sager, M.

FILING DATE: August 25, 1997

CPA FILED DATE: March 24, 2000

FOR: ELECTRONIC SYSTEM AND METHOD FOR OPERATING AN
AUXILIARY INCENTIVE GAME

**SUBSTITUTE
APPEAL BRIEF**

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Sir:

This is an Appeal under 37 C.F.R. § 1.192 from the Final Rejection of the Primary Examiner dated September 10, 2001. Each of the topics required by Rule 192 is presented herewith and is labeled appropriately.

I. REAL PARTY IN INTEREST

The real party in interest in this patent application is the party named in the caption, Thomas E. Sawyer and Tony A. Cranford.

II RELATED APPEALS AND INTERFERENCES

The Appellants know of no related appeals or interferences that will directly affect, will be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 48-55, 59-71, and 74-95 remain pending; Claims 1-47, 56-58, and 72-73 have been canceled. All currently pending claims have been finally rejected. The final rejection of Claims 48-55, 59-71, and 74-95 (shown in the Appendix) is appealed.

Claim 95 stands rejected under 35 U.S.C. § 112, first paragraph.

Claims 68-71, 74-78, and 94-95 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,586,766 to Forte et al., in view of the Ten Stix 21 game disclosed in the background of the disclosure.

Claims 68-71, 74-78, and 94-95 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,586,766 to Forte et al., in view of the Ten Stix 21 game disclosed in the background of the disclosure.

Claims 54-55, 59-65, and 67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte et al. in view of the Ten Stix 21 game in the background of the disclosure as applied to Claims 68-71, 74, and 94, and further in view of U.S. Patent No. 5,848,932 to Adams.

Claims 48-53, 66, and 75-93 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte et al. in view of the Ten Stix 21 game in the background of the disclosure as applied to Claims 68-71, 74, and 94, and further in view the patent to Adams as applied to Claims 54-65 and 67, and further in view of Pickardt (GB 2201821A).

IV. STATUS OF AMENDMENTS

No Amendments After Final Rejection have been filed in the case.

V. SUMMARY OF THE INVENTION

The invention relates to an auxiliary incentive game that is played simultaneously with a primary card game, such as blackjack, and in particular to an electronic system for displaying and controlling player's progress within the auxiliary game and for randomly awarding prizes to each player who wins the auxiliary game. The progress of each player in playing the auxiliary incentive game simultaneously with the primary card game is controlled and displayed at a gaming table. A prize display is attached to the table and the prize display indicates at least one prize available to the player who accumulates a predetermined number of bonus points playing the auxiliary game. A player interface unit is positioned on the table adjacent to each player. The player interface unit displays the number of bonus points received by the associated player. A dealer interface unit is positioned on the table adjacent to the dealer. The dealer interface unit includes control elements to allow the dealer to display the bonus points awarded to each player on the associated player interface unit and to activate a prize award control element on the player interface unit. The winning player selects a randomly indexed prize indicated on the prize display by manipulating the prize award control element on his or her player interface unit. A controller is connected to the prize display and the player and dealer interface units to control the displays and operation of the equipment. (Abstract)

The invention includes apparatuses and devices and methods for use thereof, including the following: player interface units that include bonus point displays for each player (p. 11, lns.

20-31; FIGs. 2, 5), the units having a player control element for selecting a prize (p. 15, lns. 30-31; FIG. 2); a dealer interface unit having dealer control elements for signaling the controller to display bonus points and to activate the player control element for a player receiving the winning number of bonus points (p. 17, lns. 1-24; FIG. 3, 5) and a display for displaying data, such as game control and prompting information, relating to the auxiliary game (p. 18, lns. 23-26; p. 19, lns. 6-10; FIG. 3); a controller connected to the player interface units/bonus point displays and the dealer interface unit (p. 20, lns. 21-23; p. 17, lns. 24-26; FIG. 5), the controller including features for causing the bonus point display to increment by bonus points received by the player (p. 18, lns. 17-29; FIG. 3), for signaling the controller to activate, in turn, the player control element for a player receiving a winning number of bonus points (text spanning p. 18, ln. 29 and p. 19, ln.6), for causing the bonus point display to reset upon a player receiving a winning number of bonus points (p. 14, lns. 9-11), and for controlling the light emitting elements of the prize display (p. 20, lns. 21-28); a prize display having available prizes indicated and at least one light element associated with each prize (p. 14, lns. 17-22; FIG.4), arranged, for example, in a rotational figure pattern (p. 15, lns. 1-4); the device also preventing unauthorized transfer of bonus points among players (text spanning p. 12, line 19 and page 13, line 9).

In some embodiments, the controller determines when each player has received the winning number of bonus points and, upon making the determination and receiving signaling from the dealer control element, activates the player control element for selecting a prize (text spanning p. 18, line 31 and p. 19, line 6). Embodiments also include a randomizer, such as a random generator, coupled to the controller (p. 15, lns. 10-11), the randomizer being used to select among the prizes (p. 15, lns. 11-12), such as by selecting an indexed prize at a randomly

indexed time instant (p. 15, lns. 12-15), each prize having, for example, an associated probability of selection, inversely varying with the value of the prize (p. 16, lns. 21-32). Other features of the invention include a speaker for generating a noise and flashing lights when a prize is won (p. 15, lns. 21-26).

VI. ISSUES

In the Office Action of September 10, 2001, the Examiner finally rejected Claim 95 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner rejected Claims 68-71, 74-78, and 94-95 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,586,766 to Forte, et al., in view of Ten Stix 21 game disclosed in the background of the disclosure. The Examiner rejected Claims 54-55, 59-65, and 67 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte, et al., in view of Ten Stix 21 game disclosed in the background of the disclosure and further in view of U.S. Patent No. 5,848,932 to Adams. The Examiner rejected Claims 48-53, 66, and 75-93 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte, et al., in view of the Ten Stix 21 game in the background of the disclosure as applied to Claims 68-71, 74, and 94, and further in view of the patent to Adams as applied to Claims 54-55 and 67, and further in view of British Patent No. GB 2201821A to Pickardt. The issues presented for consideration in this appeal are:

1. Whether The Examiner erred in rejecting Claim 95 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a

way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention;

2. Whether the Examiner erred in rejecting Claims 68-71, 74-78, and 94-95 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte et al. in view of the Ten Stix 21 game disclosed in the background of the disclosure;

3. Whether the Examiner erred in rejecting Claims 54-55, 59-65, and 67 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte, et al., in view of the Ten Stix 21 game disclosed in the background of the disclosure and further in view of the patent to Adams;

4. Whether the Examiner erred in rejecting Claims 48-53, 66, and 75-93 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte, et al., in view of the Ten Stix 21 game in the background of the disclosure and further in view of the patent to Adams, and further in view of the British patent to Pickardt.

VII. GROUPING OF CLAIMS

The claims do not stand or fall together, and are argued separately, below.

VIII. ARGUMENT

Background

The present application is a Continued Prosecution Application (CPA) filed March 24, 2000. The parent application for the present application was filed on August 25, 1997. All of the currently pending claims were finally rejected on September 10, 2001, and the instant appeal followed.

The record of the parent case and the present application is replete with the Examiner expressing personal preferences with regard to many aspects of examination. It appears that these personal preferences of the Examiner have carried over into the Examiner's interpretation of facts and law.¹

¹Examples of the Examiner's personal preferences include the following. In the Office Action of November 8, 1998, the Examiner rejected originally filed "system" Claims 1-20, as indefinite under 35 U.S.C. §112, second paragraph, stating that "[t]he term 'system' (clms 1 and 19, line 1 each) is indefinite for not clearly claiming the metes and bounds of the invention." In the Office Action of August 17, 1999, in rejecting Claims 22 and 31 under §102(e) or in the alternative §103(a), the Examiner found that preamble language relating to the invention including a method or device "for controlling progress in an auxiliary incentive game . . ." failed "to breath (sic) life and meaning since the language is not essential to point out the invention and the language fails to limit the structure." In the Office Action of February 8, 2001, the Examiner raised a prior public use or sale issue under §102(b) with regard to a trademark for applicants' prior art Ten Stix 21 game, and required a reply to this issue, which was not relevant to the present invention. The Examiner has repeatedly cited cases for propositions to which the cases appear clearly inapplicable. For example, in the most recent Office Action, the Examiner made the following statement with regard to his rationale for finding the complex combinations and sometimes large numbers of references "obvious"

In response to the applicant's argument that the examiner's conclusions of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment of obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicants appear to have misconstrued use of hindsight in this case. Hindsight reconstruction is proper only so long as it takes into account only knowledge within the level of ordinary skill in the art at the time the claimed invention was made and does not glean knowledge from applicant's disclosure.

This argument is addressed further in the discussion below. As part of his rejection in the final Office Action, the Examiner also states his interpretation of the applicants' Amendment prior to the final Office Action:

Applicant's failed to seasonably traverse examiner's statements (e.g. to provide help or instruction information based upon context or game/application state to aid user, to provide a plurality of games to better

1. **The Examiner erred in rejecting Claim 95 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

In the Office Action of September 10, 2001, the Examiner asserted that the limitation “independently causes the display to reset for each player in response to the number of bonus points received by each player reaching the predetermined number of bonus points” in Claim 95 is unsupported by the specification as originally filed.

attract players since having a larger selection increases the opportunity a player will find a game to their liking and stay to play, to use electronic counters and display devices for tracking and displaying counts electronically to ease record keeping duties so as to reduce counting error) is each taken as admitted prior art. *In re Chevenard*, 139 F.2d 711, 60 USPQ 239 (CCPA 1943).

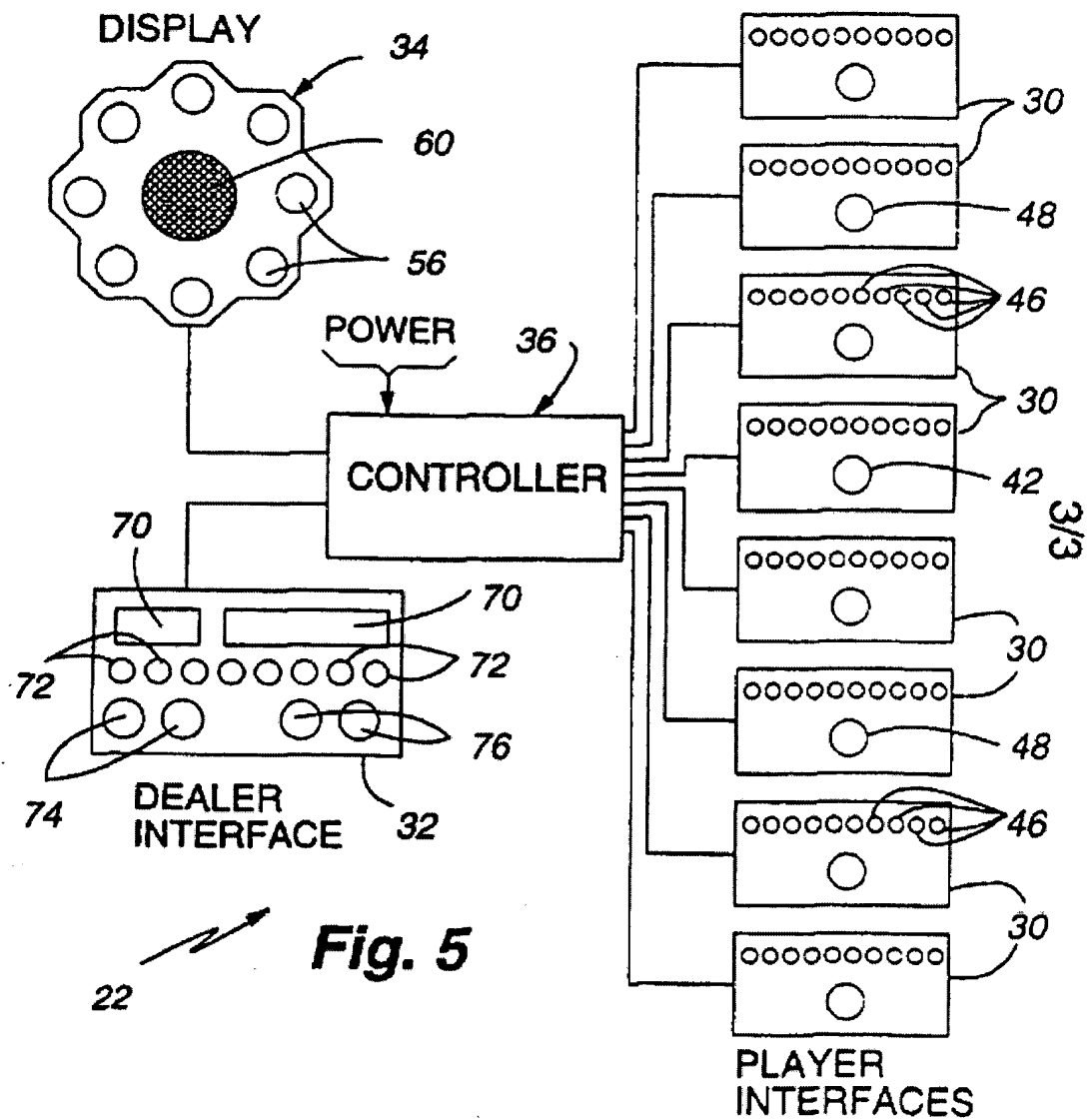
Applicants' initially note that they are somewhat confused by this statement. In any case, the Examiner's assertion that his creative motivations constitute “admitted prior art” appears misplaced. In the Amendment filed June 8, 2001, in response to the Office Action of February 8, 2001, the applicants stated once again that the Examiner had failed to make a proper rejection under §103.

The Examiner's reliance on *In re Chevenard* also appears misplaced. *In re Chevenard* involved the failure of an applicant to contradict an examiner's statement as to factual information relating to a specific claim limitation. The lack of contradiction was found to be an admission by the applicant, rendering the claim unpatentable. In contrast, in the present case, throughout prosecution, the applicants have repeatedly denied the Examiner's many unsupported and/or inapplicable “motivations” for combining references, which the Examiner has used to allow hindsight assembly of the references to piece together obviousness rejections.

Finally, the Examiner's Office Actions have progressively become more lengthy, on two occasions exceeding more than 20 pages in length. Rather than being thorough, however, these lengthy Office Actions demonstrate an absence of relevant art and motivation, requiring the Examiner to devote substantial support for his personal preferences and somewhat tenuous arguments.

Applicants submit that Claim 95 is directed to an apparatus in which a device independently causes the display to reset for each player in response to the number of bonus points received by each player reaching the predetermined number of bonus points. Support in the specification for this limitation of Claim 95 includes at least the following: “[T]ouching the activated prize selection button 48 also causes the controller 36 to reset the corresponding player interface unit 30 by deactivating the ten flashing LEDs 46 as well as turning off the light associated with the prize selection button 48. In this manner, the player interface unit 30 is ready for a subsequent auxiliary game which will start following the award of the random prize.” (Specification, page 14, lines 9-16; FIG. 5.) (See copy of FIG. 5 attached below.)

The specification thus provides support for a device that causes the display to reset, whether dependently or independently. Applicants submit that the Examiner’s rejection under §112 should therefore be reversed.



2. The Examiner erred in rejecting Claims 68-71, 74-78, and 94-95 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte et al. in view of the Ten Stix 21 game disclosed in the background of the disclosure.

The Examiner maintained his rejection of these claims from his Office Action of February 8, 2001. In the Office Action of February 8, 2001, the Examiner asserted that a number of the elements of the claims were disclosed by the patent to Forte, et al., with missing elements being either “known in gaming and computing” or disclosed by applicants’ prior art Ten Stix 21 game; alternatively, the Examiner states that a number of the features are disclosed in the prior art Ten Stix 21 game, with the patent to Forte, et al., apparently filling in the missing elements.

The motivations for the skilled artisan to make the various combinations, thereby rendering the invention obvious, according to the Examiner, include the following. He asserts that it would have been obvious to combine the features of the patent to Forte, et al., with the “well known” fact that “casino and gaming environments are typically loud and can be distracting” with it further being “known” in gaming and computing “to provide help or instruction information,” as well as that “prompting is a method of providing instructional information,” so as to render the limitation “prompting the dealer to manipulate the dealer control elements in accordance with the rules of play of the auxiliary game,” as claimed in Claim 94 obvious, apparently based on the Examiner supplied motivation “to aid the dealer [to] provide appropriate input in the loud and occasionally distracting casino environment to reduce dealer error.”

A. Claim 68

With regard to Claim 68, the Examiner states that certain claim elements are not disclosed by the patent to Forte, et al., but that these missing elements are disclosed by applicants' prior art Ten Stix 21 Game, and these references are combinable to render the invention obvious by virtue of the "well known" motivation to provide a plurality of games to increase the opportunity to find a game to the players' liking and stay and play, and further to "better hold the player's desire to continue playing the game, and to make the game more exciting to play."

With an alternative rejection, the Examiner states that "[t]he recording responsibilities of manually counting, displaying, and keeping track of each players points is burdensome upon the dealer and essentially requires the dealer to be mindful of two sets of rules and operations for the primary game and the auxiliary or secondary game," and that it is "well known in the displays or exhibitors, counters or gaming arts to use electronic counters and display devices for tracking and displaying count." According to the Examiner, the patent to Forte, et al., "discloses a game and method that electronically aids a dealer count, record, display and keep track of bonus points" to be awarded, and thus, the applicants' prior art Ten Stix game is obviously combinable with the patent to Forte, et al., with all the features and functions of the limitations claimed, along with the "prompting" limitation for overcoming the loud and occasionally distractive casino environment, for easing record keeping requirements and to better hold the player's desire to continue playing the game or to provide incentive for players to stay at the table.

Applicants submit that the prior art upon which the Examiner relies does not disclose each of the limitations of the Claim 68. Specifically, applicants submit that neither the patent to Forte, et al., nor the applicants' prior art Ten Stix game, nor any other reference cited by the

Examiner discloses or suggests at least the features of a bonus point display, a controller connected to the bonus point display, the bonus point display maintaining a number of bonus points received by each of said players when said input indicates that no new bonus point is to be awarded, and the controller causing the display to reset and to display a starting number of bonus points in response to the number of bonus points received by the associated player reaching the predetermined number of bonus points, as claimed. Nor do any of these references suggest combining the references so as to render Claim 68 obvious.

Applicants submit that the patent to Forte, et al., describes a method and system for play of a game, including an auxiliary game, potentially by use of an ante, and the simple recordation of a jackpot tally event upon its occurrence, as provided by players' notice to the dealer of such occurrence. The patent to Forte, et al., provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals. Such jackpot tally events are reset to zero upon their consecutive occurrence ending (see, e.g., col. 8. lns. 22-25, "control unit 40 forms means for zeroing, at the end of each hand, the count values of players which were not dealt a natural hand in the previous hand"). In contrast, Claim 68 claims a device for play of a game that includes a bonus point display and controller that maintains the number of bonus points until a predetermined number of bonus points is reached. The patent to Forte, et al., does not disclose or suggest a bonus point display connected to a controller having a first input device,

the controller maintaining the number of bonus points, and a second device for causing the display to reset upon a player reaching the predetermined number of bonus points, as claimed.

The applicants' prior art Ten Stix 21 game discloses an auxiliary game played with a principal or primary casino table game, in which "lammers" are optionally provided to players upon certain events occurring in the casino table game, with the accumulation of a predetermined number of lammers leading to eligibility to receive a prize, such as by spinning of a prize wheel. No bonus point display or controller, with first input and second devices, as claimed in Claim 68, are disclosed or suggested by the Ten Stix 21 game.

The Examiner's opinion of casinos and gaming environments, gaming and computing, and prompting appear entirely irrelevant to the patentability of Claim 68. To the extent that the Examiner is suggesting that any device or combination of the prior art or other features, which the Examiner solely with apparent hindsight believes to be useful, are combinable so as to render Claim 68 obvious, applicants respectfully disagree. Such a broad interpretation of the Examiner's latitude in piecing together some of the elements of the claimed invention, adding or extrapolating features based on the Examiner's assumptions of what should be added to complete the elements the Examiner has cobbled together, and then applying a generic motivation, would appear to render virtually all new games unpatentable. Generally, all new games include one or more elements that may be found in the existing art. Allowing motivations, such as "to make the game more exciting" or "to enhance record keeping" to support any arbitrary combinations of references the Examiner would like to combine, would appear to remove the entire purpose of the motivation requirement, and allows hindsight obviousness rejections, as the Examiner has improperly made.

In any event, none of the references disclose or suggest all of the limitations of Claim 68. This claim does not stand or fall with any other at least for this reason.

B. Claim 69

With regard to Claim 69, applicants submit that none of the prior art of record discloses or suggests at least a bonus point display comprising a player interface unit, the interface unit including a display element to display the number of bonus points received by an associated player, as claimed. This claim does not stand or fall with any other at least for this reason.

C. Claim 70

With regard to Claim 70, applicants submit that none of the prior art of record discloses or suggests at least a bonus point display comprising a common display mounted for easy viewing by players at the gaming table, the common display having a display element for each player, as claimed. This claim does not stand or fall with any other at least for this reason.

D. Claim 71

With regard to Claim 71, applicants submit that none of the prior art of record discloses or suggests at least a display element comprising an array of 'n' luminous indicators, where 'n' is the predetermined number of bonus points after which a prize is awarded, as claimed. This claim does not stand or fall with any other at least for this reason.

E. Claim 74

With regard to Claim 74, applicants submit that none of the prior art of record discloses or suggests at least a means for resetting the bonus point display when the associated player leaves the gaming table, as claimed. This claim does not stand or fall with any other at least for this reason.

F. Claim 75

With regard to Claim 75, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 68 further comprising a prize display, the prize display including at least one light emitting element associated with each indication, the controller being connected to the prize display and further comprising a third means for controlling the light emitting elements associated with the indications on the prize display to indicate the prized received by each player, as claimed. This claim does not stand or fall with any other at least for this reason.

G. Claim 76

With regard to Claim 76, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 75, further comprising a dealer interface unit, the dealer interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display, as claimed. This claim does not stand or fall with any other at least for this reason.

H. Claim 77

With regard to Claim 77, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 69, further comprising a prize display, the prize display including at least one light emitting element associated with each indication, the controller being connected to the prize display and further comprising a third means for controlling the light emitting elements associated with the indications on the prize display to indicate the prized received by each player, as claimed. This claim does not stand or fall with any other at least for this reason.

I. Claim 78

With regard to Claim 78, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 77, further comprising a dealer interface unit, the dealer interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display, as claimed. This claim does not stand or fall with any other at least for this reason.

J. Claim 94

With regard to Claim 94, applicants submit that none of the prior art of record discloses or suggest at least the dealer interface unit including a display for displaying game control information for a dealer, and the controller signaling the display of the dealer interface unit to display information prompting the dealer to manipulate the dealer control elements in accordance

with the auxiliary game, as claimed. This claim does not stand or fall with any other at least for this reason.

K. Claim 95

With regard to Claim 95, applicants submit that none of the prior art of record discloses or suggest at least the second device independently causing the display to reset for each player in response to the number of bonus points received by each player reaching the predetermined number of bonus points, as claimed. This claim does not stand or fall with any other at least for this reason.

L. Failure to Set Forth a Proper *Prima Facie* Case of Obviousness

With regard to the rejection under §103, the applicants again submit that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under § 103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under § 103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could be modified to meet the claim is insufficient to establish obviousness. The PTO “can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir.

1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

The use of pure hindsight is entirely improper in the context of an obviousness rejection. As the Court of Appeals for the Federal Circuit clearly and unequivocally indicated in In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998):

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet at 1357.

In re Rouffet involved the reversal of both an Examiner and the Board of Patent Appeals for improperly combining a variety of features from various references in order to reject claims as obvious. Neither the Examiner nor the Board cited a motivation from the art itself for naming the specific combinations, instead using merely a “rote invocation” of the presence of a high level of skill in the field to supply a motivation to combine the references.

Similarly, in In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), an Examiner and the Board of Patent Appeals attempted to argue that claims drawn to a pumpkin face on a garbage bag were obvious in light of well known garbage bags and various references teaching creation of pumpkin-like objects using stuffed bags. The Court of Appeals for the Federal Circuit warned against the use of hindsight even in the area of less technologically complex inventions such as this, where the temptation is great:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of

invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” . . .

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . .

In re Dembiczak at 999 (citations omitted).

Further, and more specifically, the Court of Appeals for the Federal Circuit in In re Rouffet also held:

As this court has stated “virtually all [inventions] are combinations of old elements.” . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

In re Rouffet at 1357 (citations omitted).

The Examiner made such improper hindsight combinations. The Examiner’s final Office Action reads exactly like such a blueprint based on the present invention. The Examiner lists each claimed feature as allegedly found scattered among various references, and then combines them as obvious. No motivation from within the art for making the specific combination of each element is provided. The Examiner does not show how a skilled artisan presented with the specific problems encountered, without knowledge of the present invention, would select the specific features included in the present invention.

A recent 2002 Federal Circuit decision also addresses the improper obviousness rejection issue. In re Lee held that “[w]hen patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” In re Lee, 2002 U.S. App. LEXIS 855, 9-10 (Fed. Cir. 2002). “The factual inquiry whether to combine references must be thorough and searching . . . [and] must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” Id. at 10. “The need for specificity pervades this authority.” Id. at 10. “This factual question of motivation is material to patentability and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references simply to ‘[use] that which the inventor taught against its teacher.’ . . . Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” Id. at 12.

The Examiner’s admitted use of hindsight is entirely improper in the context of an obviousness rejection, and his reliance on In re McLaughlin, a case involving the patentability of the placement and design of railroad boxcar doors, is misplaced for several reasons.

First, the court in In re McLaughlin was not even addressing the issue of the necessary motivation for combining references. Essentially, the language of that decision referenced by the Examiner stands merely for the proposition that it is possible (i.e., legally permitted) to combine references to render a claim obvious, and that, in order to create the combination, the references must be combined in the form that replicates the invention. Nowhere does the decision sanction

or even suggest as appropriate the use of hindsight in making the obviousness rejection. Quite the contrary, the court reiterates that “A patentable invention within the ambit of 35 U.S.C. § 103, may result even if the invention has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.” In re McLaughlin at 1395-1396, citing In re Spinnoble, 405 F.2d 578 (C.C.P.A. 1969).

Second, each of the prior art references in In re McLaughlin at least dealt with solving the same problem: how to most efficiently and fully fill a boxcar using various door and opening configurations. In contrast, among other things, the present invention solves the problem of how to prevent improper play of a card game in conjunction with an auxiliary game involving optional use of a card in either the card game or the auxiliary game. The references cited by the Examiner have nothing to do with solving this problem. To the extent that the Examiner believes these references are relevant because the invention solves the problem of increasing “player excitement and enjoyment” or achieving other “generic” motivations of casino or other games, it is respectfully submitted that this argument is too broad and misplaced.

Third, given the inapplicability of In re McLaughlin to the issue of motivation to combine references and the very recent, explicit decisions of the Court of Appeals for the Federal Circuit that the use of hindsight is entirely improper and must be guarded against in determining obviousness by the requirement of a clear showing from within the art of a motivation to combine the references with regard to each specific feature found obvious, this 1971 decision on the patentability of boxcar door configurations should not be relied upon to support the Examiner’s obviousness rejection.

The Examiner also cites to In re Venner, 120 U.S.P.Q. 192 (CCPA 1958), and In re Rundell, 48 F.2d 958 (CCPA 1931), when making his rejection. The Examiner has not explained why is referring to these cases. A portion of each of these opinions relates to the general proposition that “it is not ‘invention’ to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result.” (In re Venner, 48 F.2d at 95 citing In re Rundell). In In re Venner, the claims at issue related to a “time-controlled means” to actuate a fluid motor to withdraw a middle core section at the proper time after pouring metal into a mold. This simple timer, which was activated by a switch by an operator, replaced the operator determined removal of the core. In In re Rundell, the claims related to a generalized mechanism for “bunch concentrators” used in the manufacture of cigars. The applicant argued that the claims were allowable by virtue of an automatic mechanism incorporated, but not specifically claimed, in limitations (“The mere statement that a device is to be operated automatically instead of by hand, without a claim specifying any particular automatic mechanism, is not the statement of an invention,” 48 F.2d 958).

Neither case appears applicable to the present invention. Applicants’ invention is not simply a “mechanical or automatic means to replace manual activity,” as claimed in In re Venner, nor have applicants generally claimed a device and then relied solely upon only an unclaimed automatic portion for patentability. Applicants submit that such a generalized citation to these cases does not provide sufficient basis for rejection and does not rise to the level of a proper *prima facie* rejection for obviousness.

3. **The Examiner erred in rejecting Claims 54-55, 59-65, and 67 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte et al. in view of the Ten Stix 21 game disclosed in the background of the disclosure and further in view of the patent to Adams.**

The Examiner maintained his rejection of these claims from his Office Action of February 8, 2001. In the Office Action of February 8, 2001, the Examiner asserted that a number of the elements of Claims 54-55 and 59-65 and 67 were disclosed by the patent to Forte, et al., in combination with applicants' prior art Ten Stix 21 game, with missing elements being disclosed in the patent to Adams, or, for Claim 63, by "the very well known in gaming and prize distribution to provide payout or prizes with values inversely proportional to their random selection."

The motivations for these combinations, according to the Examiner, are to heighten or increase the level of anticipation and/or excitement for the player.

A. Claim 54

Applicants submit that the prior art upon which the Examiner relies does not disclose each of the limitations of the Claim 54. Specifically, applicants submit that neither the patent to Forte, et al., nor applicants' prior art Ten Stix 21 game, nor the patent to Adams, nor any other reference cited by the Examiner discloses or suggests at least the features of a device for play of an auxiliary incentive game with a card game that includes a plurality of manipulable player interface unit, each having a display element to display the number of bonus points accumulated by the player, and a controller operatively coupled to each of the interface units, the controller

controlling the display element of each unit, wherein the card game includes at least one card game bonus event, the auxiliary game includes an option for a player to receive a bonus point upon occurrence of the bonus event, such that each player has a number of bonus events, the bonus points being reset to a starting number of bonus points upon accumulation of a predetermined number of bonus points, wherein the controller causes the player interface units to reset the starting number of bonus points, and wherein the player interface units are manipulated by the players to select a prize, as claimed. This claim does not stand or fall with any other at least for this reason.

Applicants submit that the patent to Forte, et al., describes a method and system for play of a game, including an auxiliary game, potentially by use of an ante, and the simple recordation of a jackpot tally event upon its occurrence, as provided by players' notice to the dealer of such occurrence. The patent to Forte, et al., provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals. Such jackpot tally events are reset to zero upon their consecutive occurrence ending. In contrast, Claim 54 claims a device for play of a game that includes a plurality of manipulable player interface units operatively coupled to a controller that maintains the number of bonus points until a predetermined number of bonus points is reached. The patent to Forte, et al., does not disclose or suggest a plurality of manipulable player interface units operatively coupled to a controller, as claimed. The patent to

Forte, et al., in fact teaches away from the present invention, as claimed in Claim 54, specifically indicating that the player console, which displays information to a player, “does not include player keys or a dealer key” (col. 6, lns. 43-44), thus not allowing player manipulation, as claimed.

The applicants’ prior art Ten Stix 21 game discloses an auxiliary game played with a principal or primary casino table game, in which “lammers” are optionally provided to players upon certain events occurring in the casino table game, with the accumulation of a predetermined number of lammers leading to eligibility to receive a prize, such as by spinning of a prize wheel. No plurality of manipulable player interface units or controller operatively coupled thereto, as claimed in Claim 54, are disclosed or suggested by the Ten Stix 21 game.

The patent to Adams simply discloses a method of playing a game and gaming games with an additional payout indicator. No plurality of manipulable player interface units or controller operatively coupled thereto, as claimed in Claim 54, are disclosed or suggested by the patent to Adams.

B. Claim 55

With regard to Claim 55, applicants submit that none of the prior art of record discloses or suggests at least the device further including a dealer interface unit operatively coupled to the controller for signaling the controller, wherein a dealer control element of the dealer interface unit signals the controller to activate the player interface unit associated with the player accumulating the predetermined number of bonus points, and wherein the player interface unit is

activated by the controller in response to a signal from the dealer interface unit, as claimed. This claim does not stand or fall with any other at least for this reason.

C. Claim 59

With regard to Claim 59, applicants submit that none of the prior art of record discloses or suggests at least each player interface unit further includes a player control element that includes a selector, such that a selection of the price is receivable from the associated player, as claimed. This claim does not stand or fall with any other at least for this reason.

D. Claim 60

With regard to Claim 60, applicants submit that none of the prior art of record discloses or suggests at least the prize being selected from a plurality of predetermined prizes, and the device further includes a prize display operatively coupled to the controller, the prize displaying the prizes, as claimed. This claim does not stand or fall with any other at least for this reason.

E. Claims 61-65

Applicants submit that none of the prior art of record discloses all of features of Claims 61-65, including the limitations of the base claims, and that the Examiner has failed to properly combine the prior art relating to the additional features claimed in Claims 61-65.

With regard to Claim 61, applicants submit that none of the prior art of record discloses or suggests at least the device further including a randomizer operatively coupled to the controller

for randomly selecting a prize, as claimed. This claim does not stand or fall with any other at least for this reason.

With regard to Claim 62, applicants submit that none of the prior art of record discloses or suggests at least the device of Claim 61, with each of the prizes having a probability of selection, as claimed. This claim does not stand or fall with any other at least for this reason.

With regard to Claim 63, applicants submit that none of the prior art of record discloses or suggests at least the device of Claim 61, with each of the prizes having a value and a probability of selection, the value varying inversely with the probability of selection, as claimed. This claim does not stand or fall with any other at least for this reason.

With regard to Claim 64, applicants submit that none of the prior art of record discloses or suggests at least the device of Claim 54, further including a speaker to generate noise upon a prize being awarded, as claimed. This claim does not stand or fall with any other at least for this reason.

With regard to Claim 65, applicants submit that none of the prior art of record discloses or suggests at least the device of Claim 54, further including flashing lights that flash upon a prize being awarded, as claimed. This claim does not stand or fall with any other at least for this reason.

F. Claim 67

With regard to Claim 67, applicants submit that none of the prior art of record discloses or suggests at least the device of Claim 55, the dealer interface unit including a display for

displaying data regarding the auxiliary game, as claimed. This claim does not stand or fall with any other at least for this reason.

G. Failure to Set Forth a Proper *Prima Facie* Case of Obviousness

With regard to the rejections under §103, applicants submit that the Examiner again has failed to make a proper rejection, for the same reasons as indicated with regard to the rejections of Claims 68-71, 74-78, and 94-95.

4. **The Examiner erred in rejecting Claims 48-53, 66, and 75-93 under 35 U.S.C. § 103(a) as being unpatentable over the patent to Forte et al. in view of the Ten Stix 21 game in the background of the disclosure and further in view of the patent to Adams, and further in view of the British patent to Pickardt, et al.**

The Examiner maintained his rejection of these claims from his Office Action of February 8, 2001. In the Office Action of February 8, 2001, the Examiner asserted that a number of the elements of Claims 48-53, 66, and 75-93 were disclosed by a combination of the patent to Forte, et al., with applicants' prior art Ten Stix 21 game, in view of the patent to Adams, with missing elements being supplied by the patent to Pickardt, et al.

A. Claim 48

Applicants submit that the prior art upon which the Examiner relies does not disclose each of the limitations of the Claim 48. Specifically, applicants submit that neither the patent to Forte, et al., nor applicants' prior art Ten Stix 21 game, nor the patent to Adams, nor the patent to Pickardt, nor any other reference cited by the Examiner discloses or suggests at least the features of a device for controlling and displaying each player's progress in an auxiliary incentive game played simultaneously with a principal or primary casino table game that includes a bonus point display for displaying the number of bonus points received by each player, a controller connected to the bonus point display, the controller including a means for causing the display to reset and to display a starting number of bonus points in response to the number of bonus points received by the player reaching a predetermined number of bonus points, a prize display, a dealer interface unit, the bonus point display including player interface units, each player interface unit including

a player control element manipulated by the player to select a prize, the dealer control element signaling the controller to activate the player control element at the player interface unit when the predetermined number of bonus points are accumulated, and the player control element being activated by the controller in response to a signal from the dealer control elements of the dealer interface unit, as claimed. This claim does not stand or fall with any other at least for this reason.

Applicants submit that the patent to Forte, et al., describes a method and system for play of a game, including an auxiliary game, potentially by use of an ante, and the simple recordation of a jackpot tally event upon its occurrence, as provided by players' notice to the dealer of such occurrence. The patent to Forte, et al., provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals. Such jackpot tally events are reset to zero upon their consecutive occurrence ending. The patent to Forte, et al., does not disclose or suggest a plurality of manipulable player interface units, as claimed. The patent to Forte, et al., in fact teaches away from the present invention, as claimed in Claim 48, specifically indicating that the player console, which displays information to a player, "does not include player keys or a dealer key" (col. 6, lns. 43-44), thus not allowing player manipulation, as claimed.

The applicants' prior art Ten Stix 21 game discloses an auxiliary game played with a principal or primary casino table game, in which "lammers" are optionally provided to players

upon certain events occurring in the casino table game, with the accumulation of a predetermined number of lammers leading to eligibility to receive a prize, such as by spinning of a prize wheel. No bonus point display with player interface unit for each player that includes player control element manipulated by the player to select a prize, controller, prize display, dealer interface unit, as claimed in Claim 48, are disclosed or suggested by the Ten Stix 21 game.

The patent to Adams simply discloses a method of playing a game and gaming games with an additional payout indicator. No bonus point display with player interface unit for each player that includes player control element manipulated by the player to select a prize, controller, prize display, dealer interface unit, as claimed in Claim 48, are disclosed or suggested by the patent to Adams.

The patent to Pickardt, et al., discloses a coin-operated gaming machine that includes a random generator for controlling the entire course of a game, rotatable members and a rotatable disc arrestable by the operation of a stop button for determining whether a player wins the game. No bonus point display with player interface unit for each player that includes player control element manipulated by the player to select a prize, controller, prize display, dealer interface unit, as claimed in Claim 48, are disclosed or suggested by the patent to Pickardt, et al.

B. Claim 49

With regard to Claim 49, applicants submit that none of the prior art of record discloses or suggests at least the controller of Claim 48 further determining when each player has received the predetermined number of bonus points, and the player control element used to select the prize being activated by the controller upon determining that the predetermined number of bonus

points has been accumulated and upon signaling from the dealer control elements, as claimed. This claim does not stand or fall with any other at least for this reason.

C. Claim 50

With regard to Claim 50, applicants submit that neither the patent to Forte, et al., nor applicants' prior art Ten Stix 21 game, nor the patent to Adams, nor the patent to Pickardt, nor any other reference cited by the Examiner discloses or suggests at least the features of a device for controlling and displaying each player's progress in an auxiliary incentive game played with a primary casino table game that includes a bonus point display, a controller connected to the bonus point display that causes the display of the starting number of bonus points for a player in response to that player receiving the predetermined number of bonus points, a prize display, a dealer interface unit, the bonus point display including a player interface unit for each player, the player interface unit including a player control element manipulated by the player to select a prize, as claimed. This claim does not stand or fall with any other at least for this reason.

Applicants submit that the patent to Forte, et al., describes a method and system for play of a game, including an auxiliary game, potentially by use of an ante, and the simple recordation of a jackpot tally event upon its occurrence, as provided by players' notice to the dealer of such occurrence. The patent to Forte, et al., provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low

probability dealer events such as consecutive dealer busts or naturals. Such jackpot tally events are reset to zero upon their consecutive occurrence ending. The patent to Forte, et al., does not disclose or suggest a plurality of manipulable player interface units, as claimed. The patent to Forte, et al., in fact teaches away from the present invention, as claimed in Claim 50, specifically indicating that the player console, which displays information to a player, “does not include player keys or a dealer key” (col. 6, Ins. 43-44), thus not allowing player manipulation, as claimed.

The applicants’ prior art Ten Stix 21 game discloses an auxiliary game played with a principal or primary casino table game, in which “lammers” are optionally provided to players upon certain events occurring in the casino table game, with the accumulation of a predetermined number of lammers leading to eligibility to receive a prize, such as by spinning of a prize wheel. No bonus point display with player interface unit for each player that includes player control element manipulated by the player to select a prize, controller, prize display, dealer interface unit, as claimed in Claim 48, are disclosed or suggested by the Ten Stix 21 game.

The patent to Adams simply discloses a method of playing a game and gaming games with an additional payout indicator. No bonus point display with player interface unit for each player that includes a bonus point display that includes a player interface unit for each player, the player interface unit being manipulable by the player to select a prize, a controller, prize display, and a dealer interface unit, as claimed in Claim 50, are disclosed or suggested by the patent to Adams.

The patent to Pickardt, et al., discloses a coin-operated gaming machine that includes a random generator for controlling the entire course of a game, rotatable members and a rotatable

disc arrestable by the operation of a stop button for determining whether a player wins the game. No bonus point display with player interface unit for each player that includes a bonus point display that includes a player interface unit for each player, the player interface unit being manipulable by the player to select a prize, a controller, prize display, and a dealer interface unit, as claimed in Claim 50, are disclosed or suggested by the patent to Pickardt, et al.

D. Claim 51

With regard to Claim 51, applicants submit that none of the prior art of record discloses or suggests at least the device of Claim 50, the controller further determining when each player has received the predetermined number of bonus points entitling selection of the prize, and the player control element used by the player to select a prize being activated upon the controller determining that the player has received the predetermined number of bonus points upon signaling from the dealer control elements, as claimed. This claim does not stand or fall with any other at least for this reason.

E. Claim 52

With regard to Claim 52, applicants submit that neither the patent to Forte, et al., nor applicants' prior art Ten Stix 21 game, nor the patent to Adams, nor the patent to Pickardt, et al., nor any other reference cited by the Examiner discloses or suggests at least the features of a method for a plurality of players to play an auxiliary game in conjunction with playing a card game, including providing a bonus point display for displaying the bonus level for each player, the bonus point display including a plurality of player interface units, each of the units including a

player control element manipulable by the player to select a prize, providing a controller connected to the bonus point display for causing the display to reset to the starting level in response to the bonus level of the associated player reaching the prize level, providing a prize display, providing a dealer interface unit, including dealer control elements for signaling the controller, the controller causing the player interface unit to reset the display element to display the starting level, the dealer control elements signaling the controller to activate the player control element at the player interface unit associated with the player reaching the bonus level, the controller activating the player interface unit in response to a signal from the dealer control elements, the player reaching the bonus level manipulating the player control element to select to generate a prize, and generating the prize for the player from a plurality of random prizes, as claimed. This claim does not stand or fall with any other at least for this reason.

Applicants submit that the patent to Forte, et al., describes a method and system for play of a game, including an auxiliary game, potentially by use of an ante, and the simple recordation of a jackpot tally event upon its occurrence, as provided by players' notice to the dealer of such occurrence. The patent to Forte, et al., provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals. Such jackpot tally events are reset to zero upon their consecutive occurrence ending. The patent to Forte, et al., does not disclose or suggest manipulating player interface units, as claimed. The patent to Forte, et al., in

fact teaches away from the present invention, as claimed in Claim 52, specifically indicating that the player console, which displays information to a player, “does not include player keys or a dealer key” (col. 6, lns. 43-44), thus not allowing player manipulation, as claimed.

The applicants’ prior art Ten Stix 21 game discloses an auxiliary game played with a principal or primary casino table game, in which “lammers” are optionally provided to players upon certain events occurring in the casino table game, with the accumulation of a predetermined number of lammers leading to eligibility to receive a prize, such as by spinning of a prize wheel. No manipulating of the player control element, or providing of a bonus point display, controller, prize display, or dealer interface unit, as claimed in Claim 52, are disclosed or suggested by the Ten Stix 21 game.

The patent to Adams simply discloses a method of playing a game and gaming games with an additional payout indicator. No manipulating of the player control element, or providing of a bonus point display, controller, prize display, or dealer interface unit, as claimed in Claim 52, are disclosed or suggested by the patent to Adams.

The patent to Pickardt, et al., discloses a coin-operated gaming machine that includes a random generator for controlling the entire course of a game, rotatable members and a rotatable disc arrestable by the operation of a stop button for determining whether a player wins the game. No manipulating of the player control element, or providing of a bonus point display, controller, prize display, or dealer interface unit, as claimed in Claim 52, are disclosed or suggested by the patent to Pickardt, et al.

F. Claim 53

With regard to Claim 53, applicants submit that none of the prior art of record discloses or suggests at least the method of Claim 52, the controller further determining when each player has reached the prize level, the prize level entitling the player to select the prize, and the controller activating the player control element to select the prize upon determining that the player has reached the prize level and upon signaling from the dealer control elements, as claimed. This claim does not stand or fall with any other at least for this reason.

G. Claim 75

With regard to Claim 75, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 68, the prize display further including an indication of at least one prize available to each player who accumulates the predetermined number of bonus points, the prize display including a light emitting element associated with each indication, the controller being connected to the prize display and further comprising third means for controlling the light emitting elements associated with the indications on the prize display to indicate the prize received by each player, as claimed. This claim does not stand or fall with any other at least for this reason.

H. Claim 76

With regard to Claim 76, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 75, further including a dealer interface unit associated with the dealer of the primary game and positioned on the table adjacent to the dealer, the dealer

interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display, as claimed. This claim does not stand or fall with any other at least for this reason.

I. Claim 77

With regard to Claim 77, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 69, further including a prize display that includes an indication of at least one prize available to each player who accumulates the predetermined number of bonus points, the prize display including at least one light emitting element associated with each indication, the controller being connected to the prize display and further comprising third means for controlling the light emitting elements associated with the indications on the prize display to indicate the prize received by each player, as claimed. This claim does not stand or fall with any other at least for this reason.

J. Claim 78

With regard to Claim 78, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 77, further including a dealer interface unit associated with the dealer of the primary game and positioned on the table adjacent to the dealer, the dealer interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display, as claimed. This claim does not stand or fall with any other at least for this reason.

K. Claim 79

With regard to Claim 79, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 78, the player interface unit further comprising a player control element manipulated by the associated player to select the prize, as claimed. This claim does not stand or fall with any other at least for this reason.

L. Claim 80

With regard to Claim 80, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 79, the dealer control elements of the dealer interface unit also signaling the controller to activate the player control element at the player interface unit associated with the player who has accumulated the predetermined number of bonus points, and the player control element used by the player to select the prize being activated at the player interface unit by the controller in response to a signal from the dealer control elements of the dealer interface unit, as claimed. This claim does not stand or fall with any other at least for this reason.

M. Claim 81

With regard to Claim 81, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 80, the controller further determining when each player has received the predetermined number of bonus points which entitles the player to select the prize, and the player control element used by the player to select the prize being activated by the controller upon determining that the player has received the predetermined number of bonus

points and upon signaling from the dealer control elements, as claimed. This claim does not stand or fall with any other at least for this reason.

N. Claim 82

With regard to Claim 82, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 79 the prize display including indications of a plurality of different prizes available to each player who accumulates the predetermined number of bonus points, and the controller randomly selecting one of the plurality of different prizes in response to the manipulation of the activated player control element of the player interface unit by the associated player, as claimed. This claim does not stand or fall with any other at least for this reason.

O. Claim 83

With regard to Claim 83, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 82, the controller including a random generator, the controller causing the random generator to select each of the prizes on a random basis, and the manipulation of the player control element by the associated player signaling the random generator to select one of the prizes, as claimed. This claim does not stand or fall with any other at least for this reason.

P. Claim 84

With regard to Claim 84, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 83, the random generator indexing through each of the different prizes on a random basis, and the time instant when the player control element is manipulated being correlated to the one of the prizes which is indexed by the random generator, as claimed. This claim does not stand or fall with any other at least for this reason.

Q. Claim 85

With regard to Claim 85, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 83, the controller establishing different odds for the random generator to select each of the prizes, as claimed. This claim does not stand or fall with any other at least for this reason.

R. Claim 86

With regard to Claim 86, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 85, each of the different prizes having a different value, and the controller establishing lesser odds for selecting the greater valued prizes, as claimed. This claim does not stand or fall with any other at least for this reason.

S. Claim 87

With regard to Claim 87, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 82, the prize display including a separate indication for

each of the different prizes, and the controller signaling the prize display to light the light emitting element of each indication of each prize immediately prior to the selection of the prize resulting from the associated player manipulating the player control element of the player interface unit, as claimed. This claim does not stand or fall with any other at least for this reason.

T. Claim 88

With regard to Claim 88, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 87, the controller signaling the prize display to light the light emitting element of each prize indication in a predetermined sequence, as claimed. This claim does not stand or fall with any other at least for this reason.

U. Claim 89

With regard to Claim 89, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 88, the indications of each prize being positioned on the prize display in a predetermined pattern capable of exhibiting a sequence, and the predetermined sequence of lighting the light emitting elements of each prize indication being correlated to the predetermined pattern of indications on the prize display, as claimed. This claim does not stand or fall with any other at least for this reason.

V. Claim 91

With regard to Claim 91, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 88, further including a speaker connected to the

controller, the controller further including a tone generator connected to the speaker and operative to produce a predetermined audible sound from the speaker during lighting the light emitting elements of each prize indication, as claimed. This claim does not stand or fall with any other at least for this reason.

W. Claim 92

With regard to Claim 92, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 77, further including a speaker connected to the controller, the controller further including a tone generator connected to the speaker and operative to produce a predetermined audible sound from the speaker during lighting of the light emitting elements of the prize indications prior to selection of the prize, as claimed. This claim does not stand or fall with any other at least for this reason.

X. Claim 93

With regard to Claim 93, applicants submit that none of the prior art of record discloses or suggests at least and the apparatus of Claim 92, the controller controlling the tone generator to produce an audible sound from the speaker when a bonus point is displayed at each player interface unit, as claimed. This claim does not stand or fall with any other at least for this reason.

Y. Claims 66 and 90

Applicants submit that none of the prior art of record discloses all of features of Claims 66 and 90, including the limitations of the base claims, and that the Examiner has failed to properly combine the prior art relating to the additional features claimed in Claims 66 and 90.

With regard to Claim 66, applicants submit that none of the prior art of record discloses or suggests at least the device of Claim 60, the prize display including a plurality of lights, at least one from the plurality of lights corresponding to each of the plurality of predetermined prizes, as claimed. This claim does not stand or fall with any other at least for this reason.

With regard to Claim 90, applicants submit that none of the prior art of record discloses or suggests at least the apparatus of Claim 89, the predetermined pattern being a rotational figure, and the predetermined sequence being a rotational sequence around the rotational figure pattern of indications, as claimed. This claim does not stand or fall with any other at least for this reason.

Z. Failure to Set Forth a Proper *Prima Facie* Case of Obviousness

With regard to the rejections under §103, applicants submit that the Examiner again has failed to make a proper rejection, for the same reasons as indicated with regard to the rejections of Claims 48-53, 66, and 75-93.

IX. CONCLUSION

In view of the foregoing, it is submitted that the rejections of Claims 48-55, 59-71, and 74-95 are improper and should not be sustained. Therefore, a reversal of the Final Rejection of the Examiner is respectfully requested.

Respectfully submitted,
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APPENDIX

Claims

48. A device for controlling and displaying each player's progress in an auxiliary incentive game played simultaneously with a principal or primary casino table game directed by a dealer or croupier and played on a gaming table, the auxiliary game involving each player receiving bonus points during the course of playing the primary game and each player being eligible to receive a prize only after accumulating a predetermined number of bonus points, said device comprising:

a bonus point display for displaying the number of bonus points received by each player at the game table;

a controller connected to the bonus point display and having first means for causing the display to display an incremented number of bonus points received by each player as new bonus points are received by each player, and second means for causing the display to reset and to display a starting number of bonus points in response to the number of bonus points received by the associated player reaching the predetermined number of bonus points;

a prize display including an indication of at least one prize available to each player who accumulates the predetermined number of bonus points, the prize display including at least one light emitting element associated with each indication, the controller being connected to the prize display and further comprising third means for controlling the light emitting elements associated with the indications on the prize display to indicate the prize received by each player; and

a dealer interface unit associated with the dealer of the primary game and positioned on the table adjacent to the dealer, the dealer interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display;

5 wherein the bonus point display comprises a player interface unit associated with each player of the primary game and positioned on the gaming table adjacent to the player of the primary game, each player interface unit including a display element to display the number of bonus points received by the associated player, the second means causing the player interface unit to reset the display element to display the starting number of bonus points;

10 wherein the player interface unit further comprises a player control element manipulated by the associated player to select the prize;

wherein the dealer control element of the dealer interface unit also signals the controller to activate the player control element at the player interface unit associated with the player who has accumulated the predetermined number of bonus points;

15 wherein the player control element used by the player to select the prize is activated at the player interface unit by the controller in response to a signal from the dealer control elements of the dealer interface unit; and

wherein the device prevents unauthorized transfer of the accumulated bonus points to and from each player.

20 49. The device of claim 48, wherein the controller further determines when each player has received the predetermined number of bonus points which entitles the player to select the prize; and

wherein the player control element used by the player to select the prize is activated by the

controller upon determining that the player has received the predetermined number of bonus points and upon signaling from the dealer control elements.

50. A device for controlling and displaying each player's progress in an auxiliary incentive game played simultaneously with a primary casino table game directed by a dealer and played on a gaming table, the auxiliary game involving each player receiving bonus points during the course of playing the primary game and each player being eligible to receive a prize only after accumulating a predetermined number of bonus points, the device comprising:

a bonus point display for displaying the number of bonus points received by each player at the game table; and

a controller connected to the bonus point display for causing the display to display an incremented number of bonus points received by each player as new bonus points are received by each player, and for causing the display to reset and to display a starting number of bonus points in response to the number of bonus points received by the associated player reaching the predetermined number of bonus points;

a prize display including an indication of at least one prize available to each player who accumulates the predetermined number of bonus points, the prize display including at least one light emitting element associated with each indication, the controller being connected to the prize display, the controller further controlling the light emitting elements associated with the indications on the prize display to indicate the prize received by each player;

a dealer interface unit associated with the dealer of the primary game and positioned on the table adjacent to the dealer, the dealer interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display;

wherein the bonus point display comprises a player interface unit associated with each player of the primary game and positioned on the gaming table adjacent to the player of the primary game, each player interface unit including a display element to display the number of bonus points received by the associated player, the controller causing the player interface unit to
5 reset the display element to display the starting number of bonus points;

wherein the player interface unit further comprises a player control element manipulated by the associated player to select the prize.

51. The device of claim 50, wherein the controller further determines when each player has received the predetermined number of bonus points which entitles the player to select the
10 prize; and

wherein the player control element used by the player to select the prize is activated by the controller upon determining that the player has received the predetermined number of bonus points and upon signaling from the dealer control elements.

52. A method for a plurality of players to play an auxiliary game in conjunction with
15 playing a card game with a plurality of cards, the method comprising:

providing the card game and the auxiliary game, the card game including bonus events, and the auxiliary game including a plurality of successive bonus levels, at least one from the plurality of successive bonus levels being a starting level and at least one from the plurality of successive bonus levels being a prize level for which a prize is awarded, each of the plurality of
20 players having a player bonus level, the player bonus level being selected from the plurality of successive bonus levels;

providing a bonus point display for displaying the bonus level of each of the plurality of

7 players, the bonus point display comprising a plurality of player interface units, each of the plurality of player interface units being associated with one from the plurality of players, wherein each of the plurality of player interface units includes a display element and a player control element manipulable by the associated player to select the prize; and

5 providing a controller connected to the bonus point display for causing the display to display the bonus level of each of the plurality of players, and for causing the display to reset and to display the starting level in response to the bonus level of the associated player reaching the prize level;

10 providing a prize display, the prize display including an indication of at least one prize available to each player reaching the prize level and at least one light emitting element associated with each indication, wherein the controller is connected to the prize display, the controller further controlling the light emitting elements associated with the indication on the prize display to indicate the prize received by each player;

15 providing a dealer interface unit associated with the dealer of the primary game, the dealer interface unit including dealer control elements for signaling the controller to display the bonus level for each player on the bonus display;

initiating the play of the card game;

at least one of the bonus events occurring, the at least one of the bonus events being associated with one from the plurality of players;

20 displaying the bonus level of each of the plurality of players;

upon the at least one bonus events occurring, providing to the one from the plurality of players an option to select to advance at least one bonus level;

receiving a selection of the option to select to advance at least one bonus level; and
if the one from the plurality of players advances to the prize level, the controller causing
the player interface unit to reset the display element to display the starting level;

the dealer control elements of the dealer interface unit signaling the controller to
5 activate the player control element at the player interface unit associated with the player
reaching the bonus level;

the controller activating at the player interface unit in response to a signal from the
dealer control elements of the dealer interface unit;

the player reaching the bonus level manipulating the player control element to
10 select to generate the prize; and

generating the prize for the one from the plurality of players from a plurality of
random prizes.

53. The method of claim 52, further comprising:

the controller determining when each player has reached the prize level, the prize level
15 entitling the player to select the prize; and

the controller activating the player control element to select the prize upon determining
that the player has reached the prize level and upon signaling from the dealer control elements.

54. A device for play of an auxiliary incentive game by a plurality of players
simultaneously with a card game played with a plurality of cards by the plurality of players, the
20 device comprising:

a plurality of manipulable player interface units, each of the plurality of player interface
units associated with one from the plurality of players, and each of the plurality of player

interface units including a display element to display the number of bonus points accumulated by the associated player; and

a controller operatively coupled to each of the plurality of player interface units, the controller controlling the display element of each of the plurality of player interface units;

5 wherein the card game includes at least one card game bonus event, wherein the auxiliary game includes providing an option for one from the plurality of players to select to receive a bonus point in the auxiliary game upon occurrence of the at least one card game bonus event, such that each of the plurality of players has a number of bonus points, and wherein one from the plurality of players is provided a prize upon accumulating a predetermined number of bonus
10 points and the bonus points of the one from the plurality of players is reset to a starting number of bonus points upon accumulating the predetermined number of bonus points;

wherein the controller causes the player interface unit to reset the display element to display the starting number of bonus points;

wherein the player interface unit is manipulated by the associated player to select the
15 prize.

55. The device of claim 54, further comprising:

a dealer interface unit operatively coupled to the controller for signaling the controller;

wherein the dealer control element of the dealer interface unit signals the controller to activate the player interface unit associated with the player who has accumulated the
20 predetermined number of bonus points; and

wherein the player interface unit is activated by the controller in response to a signal from the dealer interface unit.

59. The device of claim 54, wherein each of the plurality of player interface units further comprises a player control element, the player control element including a selector, such that a selection of the prize is receivable from the associated one from the plurality of players.

60. The device of claim 54, wherein the prize is selected from a plurality of
5 predetermined prizes, the device further comprising a prize display operatively coupled to the controller, the prize display displaying the plurality of predetermined prizes.

61. The device of claim 60, further comprising a randomizer operatively coupled to the controller, the randomizer randomly selecting the prize from the plurality of predetermined prizes.

10 62. The device of claim 61, wherein each of the plurality of predetermined prizes has an associated probability of selection.

63. The device of claim 61, wherein each of the plurality of predetermined prizes has an associated value and an associated probability of selection, the associated value of each of the plurality of predetermined prizes varying inversely with the associated probability of selection.

15 64. The device of claim 54, further comprising a speaker, wherein the speaker generates a noise upon the prize being awarded.

65. The device of claim 54, further comprising flashing lights, the flashing lights flashing upon the prize being awarded.

20 66. The device of claim 60, wherein the prize display includes a plurality of lights, at least one from the plurality of lights corresponding to each of the plurality of predetermined prizes.

67. The device of claim 55, wherein the dealer interface unit includes a display for displaying data regarding the auxiliary game.

68. An apparatus for controlling and displaying each player's progress in an auxiliary incentive game played simultaneously with a principal or primary casino table game directed by a dealer or croupier and played on a gaming table, the auxiliary game involving each player receiving bonus points during the course of playing the primary game and each player being eligible to receive a prize only after accumulating a predetermined number of bonus points, said apparatus comprising:

a bonus point display for displaying the number of bonus points received by each of a plurality of players at the gaming table; and

a controller connected to the bonus point display and having first input device receiving an input indicating a bonus point award for each of said players and causing the display to display an incremented number of bonus points received by each player when said input indicates that new bonus points are to be awarded to each player, and to maintain a number of bonus points received by each of said players when said input indicates that no new bonus point is to be awarded, and a second device causing the display to reset and to display a starting number of bonus points in response to the number of bonus points received by the associated player reaching the predetermined number of bonus points.

69. An apparatus as defined in claim 68, wherein the bonus point display comprises a player interface unit associated with each player of the primary game and positioned on the gaming table adjacent to the player of the primary game, each player interface unit including a display element to display the number of bonus points received by the associated player.

70. An apparatus as defined in claim 68, wherein the bonus point display comprises a common display mounted for easy viewing by players at the gaming table, the common display having a display element for each player.

71. An apparatus as defined in claim 70, wherein the display element comprises an array of 'n' luminous indicators, where 'n' is the predetermined number of bonus points after which a prize is awarded.

74. An apparatus as defined in claim 68, further comprising:
means for resetting the bonus point display when the associated player leaves the gaming table.

75. An apparatus as defined in claim 68, further comprising:
a prize display including an indication of at least one prize available to each player who accumulates the predetermined number of bonus points, the prize display including at least one light emitting element associated with each indication, the controller being connected to the prize display and further comprising third means for controlling the light emitting elements associated with the indications on the prize display to indicate the prize received by each player.

76. An apparatus as defined in claim 75, further comprising:
a dealer interface unit associated with the dealer of the primary game and positioned on the table adjacent to the dealer, the dealer interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display.

77. An apparatus as defined in claim 69, further comprising:
a prize display including an indication of at least one prize available to each player who accumulates the predetermined number of bonus points, the prize display including at least one

light emitting element associated with each indication, the controller being connected to the prize display and further comprising third means for controlling the light emitting elements associated with the indications on the prize display to indicate the prize received by each player.

78. An apparatus as defined in claim 77, further comprising:

5 a dealer interface unit associated with the dealer of the primary game and positioned on the table adjacent to the dealer, the dealer interface unit including dealer control elements for signaling the controller to display bonus points on the bonus point display.

79. An apparatus as defined in claim 78, wherein:

10 the player interface unit further comprises a player control element manipulated by the associated player to select the prize.

80. An apparatus as defined in claim 79, wherein:

the dealer control elements of the dealer interface unit also signal the controller to activate the player control element at the player interface unit associated with the player who has accumulated the predetermined number of bonus points; and

15 the player control element used by the player to select the prize is activated at the player interface unit by the controller in response to a signal from the dealer control elements of the dealer interface unit.

81. An apparatus as defined in claim 80, wherein:

20 the controller further determines when each player has received the predetermined number of bonus points which entitles the player to select the prize; and

the player control element used by the player to select the prize is activated by the controller upon determining that the player has received the predetermined number of bonus points and upon signaling from the dealer control elements.

82. An apparatus as defined in claim 79 wherein:

5 the prize display includes indications of a plurality of different prizes available to each player who accumulates the predetermined number of bonus points; and

the controller randomly selects one of the plurality of different prizes in response to the manipulation of the activated player control element of the player interface unit by the associated player.

10 83. An apparatus as defined in claim 82, wherein:

the controller includes a random generator;

the controller causes the random generator to select each of the prizes on a random basis;

and

15 the manipulation of the player control element by the associated player signals the random generator to select one of the prizes.

84. An apparatus as defined in claim 83, wherein:

the random generator indexes through each of the different prizes on a random basis; and

the time instant when the player control element is manipulated is correlated to the one of the prizes which is indexed by the random generator.

20 85. An apparatus as defined in claim 83, wherein the controller establishes different odds for the random generator to select each of the prizes.

86. An apparatus as defined in claim 85, wherein:

each of the different prizes has a different value; and

the controller establishes lesser odds for selecting the greater valued prizes.

87. An apparatus as defined in claim 82, wherein:

the prize display includes a separate indication for each of the different prizes; and

5 the controller signals the prize display to light the light emitting element of each indication of each prize immediately prior to the selection of the prize resulting from the associated player manipulating the player control element of the player interface unit.

88. An apparatus as defined in claim 87, wherein:

10 the controller signals the prize display to light the light emitting element of each prize indication in a predetermined sequence.

89. An apparatus as defined in claim 88, wherein:

the indications of each prize are positioned on the prize display in a predetermined pattern capable of exhibiting a sequence; and

15 the predetermined sequence of lighting the light emitting elements of each prize indication is correlated to the predetermined pattern of indications on the prize display.

90. An apparatus as defined in claim 89, wherein:

the predetermined pattern is a rotational figure; and

the predetermined sequence is a rotational sequence around the rotational figure pattern of indications.

20 91. An apparatus as defined in claim 88, further including:

a speaker connected to the controller; and wherein:

the controller further includes a tone generator connected to the speaker and operative to produce a predetermined audible sound from the speaker during lighting the light emitting elements of each prize indication.

92. An apparatus as defined in claim 77, further including:

5 a speaker connected to the controller; and wherein:

the controller further includes a tone generator connected to the speaker and operative to produce a predetermined audible sound from the speaker during lighting of the light emitting elements of the prize indications prior to selection of the prize.

93. An apparatus as defined in claim 92, wherein:

10 the controller controls the tone generator to produce an audible sound from the speaker when a bonus point is displayed at each player interface unit.

94. An apparatus as defined in claim 68, wherein:

the dealer interface unit includes a display for displaying game control information to the dealer; and

15 the controller signals the display of the dealer interface unit to display information prompting the dealer to manipulate the dealer control elements in accordance with the auxiliary game.

95. The apparatus of Claim 68, wherein the second device independently causes the display to reset for each player in response to the number of bonus points received by each player
20 reaching the predetermined number of bonus points.